

REMARKS

Applicants are in receipt of an Office Action mailed May 24, 2004, rejecting claims 1, 2 and 9.

However, in the Preliminary Amendment filed of even date with the filing of this application, all of claims 1-21 were cancelled in favor of new claims 22-42. A copy of the Preliminary Amendment, together with applicants' postal card receipt is shown to demonstrate that the examiner has acted on cancelled claims.

For purposes of the following comments, however, applicants present that claims 22, 23 and 30 are analogous to claims 1, 2 and 9 treated in the Office Action and, furthermore, that claims 22 and 30 are generic with claim 23 being readable on the "elected" species. Applicants are mindful that upon allowance of a generic claim, a reasonable number of species, such as those contained in claims 24-29, should also be examined on the merits.

Claims 31-42, directed to the non-elected method have been cancelled, but applicants expressly reserve their right to file one or more divisional application(s) directed to the non-elected subject matter claiming the benefits afforded by 35 U.S.C. §119, 120 and 121.

Reconsideration of the previous rejection of the claims under 35 U.S.C. §112 is respectfully requested.

As noted hereinabove, claims 1, 2 and 9 had previously been cancelled before the examiner's alleged examination of these claims. Insofar as claims 22, 23 and 30 are analogous to claims 1, 2 and 9, they contain no allegedly objectionable terms as noted by the examiner

in the preceding Office Action. Accordingly, withdrawal of the rejection is respectfully requested.

Previous claims 1 and 9 were rejected, alternatively, under 35 U.S.C. §102(b) allegedly as being anticipated by Cannady, Jr. (U.S. Patent 4,540,624) or under EP 0,248,237.

In construing the claims, the examiner erroneously concluded that particles of electrically conducting material, i.e., carbon fibers, must be present throughout the paper sheet. See, for example, the paragraph bridging pages 3-4 of the Office Action.

However, the present invention is useable for constructing floor planks in which such floor planks are usually provided with a decorative paper (12) in the top walked on-layer which decorative paper is made of cellulose, i.e., non-electrically conducting; See, the paragraph bridging pages 1-2 of the present invention. If, as the examiner suggests, special papers are to be manufactured which contained electrically conductive particles uniformly distributed throughout, the types of papers which could be used as decorative papers would be severely restricted and those papers that are electrically conductive would be more costly than the papers now used.

Accordingly, one of the primary purposes of applicants' invention is to make an electrically conductive plank in which a paper, devoid of electrically conducting particles is used as the decorative layer.

In order to emphasize such features, claim 22 has been amended in "Jepson" format to stress that the "decorative paper is non-electrically conducting" and, wherein the improvement comprises "particles of an electrically conducting material applied to the back of the decorative

paper to make the plank electrically conductive.” Such a teaching is not found in any of the cited references relied upon by the examiner in the rejections. Thus, the paper print sheet of Cannady having uniformly distributed carbon fibers, i.e., electrically conducting material, can not meet the limitations of the claimed invention in which the paper laminate panel is provided with “a non-electrically conductive decorating paper (12) in the top walked-on layer.” Nor can the alternative reference EP 0,248,237 (hereinafter EP ‘237) meet these limitations as EP ‘237 discloses a conductive laminated paper sheet (3) wherein the decorative melamine-resin treated paper surface layer (5) does not have “particles of an electrically conducting material applied to the back of the decorative paper to make the plank electrically conductive.” Applicants reiterate that the invention would also not be obvious over EP ‘237 because it is applicants intention to use the decorative papers commonly available which are non-electrically conducting and contain no electrically conducting particles therein. Contrary to what the examiner is alleging in the Office Action that it would have been obvious in the art to uniformly distribute finely divided metal powder in forming a paper layer of EP ‘237; because applicants do not uniformly distribute finely divided metal powder (claim 23) in the decorative paper itself, but, rather, apply it to the back of the decorative paper as stated in claims 22 and 23.

The alternative rejections of either claim 2 and 9 over the combination of EP ‘237 and further in view of JP 4-145992A; or over Cannady and further in view of Metta et al (U.S. Patent 5,879,781) or the still further alternative rejection of claims 1-2 and 9 under 35 U.S.C. §103(a) as unpatentable over EP ‘237 in view of Dong et al (U.S. 2002/0136862) and Helman et al (U.S. Patent 4,906,497) are all respectfully traversed.

As noted above, neither of EP '237 or Cannady teach the claimed invention of providing electrically conducting particles on the back of a non-conducting decorative paper. It is only the examiner's misconstruction of the claim terms that would have permitted even the citation of these documents to be colorably alleged to teach the claimed invention. However, in view of the foregoing amendments, it is clear that the examiner has no basis to allege the decorative paper used in applicants' invention has any type of electrically conductive particles disposed therein, whether of the carbon fiber type of Cannady, the fine particles of EP '237 or the iron powder having "an excellent electric conductivity" as shown in the Japanese reference. Moreover, the examiner's understanding of the limitations of claim 9 are also inappropriate.

Claim 9 is directed to the feature shown in the figure in which element 16 (opposite the decor paper 14) is the counteracting layer which prevents support 10 from curling upwards due to any shrinkage in decorative paper 12 after pressing; See, page 4, 1<sup>st</sup> full paragraph of the specification. Although in analyzing the Cannady reference, the examiner asserts that "the remaining bottom layers are capable of preventing the top most layer from curling since these provide structure rigidity to a resultant decorative laminate," the remaining bottom layers 11 of Cannady are described as a "core layer"; See, column 4, lines 44-49 and drawing Figs. 1 and 2. In effect, core layer 11 is equivalent to the "support" claimed in claim 30 and there is no such "counteracting layer (16)" which prevents the support from curling upwards in the event of shrinkage of the decorative paper in Cannady. Similarly, EP '237 also lacks any teachings of a counteracting layer opposite the decorative paper so as to prevent the core from curling in the event of shrinkage of the decorative paper. Because neither of the primary references teach

the presence of the counteracting layer (16), how could either possibly teach or make obvious applying electrically conductive particles to such counteracting layer? The use of a "hot-melt adhesive" (as shown by Dawn or Helman) does not correct the foregoing deficiencies in the failure of the primary references to teach counteracting layer (16). These references do not establish a *prima facie* case of obviousness in combination with the primary references. Accordingly, withdrawal of all rejections and passage of the application to issue are respectfully requested.

In the event that any generic claim is allowable, applicants remind the examiner that he is required to also examine a reasonable number of species which would be included in claims 24-29.

Respectfully submitted,



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Date: August 24, 2004

## **ATTACHMENT**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ulrich WINDMOLLER et al

Attn: Applications

Serial No.: To be assigned

Filed: January 22, 2002

For: FLOOR PLANK AND METHOD OF MANUFACTURING IT

PRELIMINARY AMENDMENT

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

Prior to calculation of the filing fee and examination on the merits, please amend the above-identified application as follows:

IN THE SPECIFICATION

Page 1, after the title, but prior to the first line, please insert the following heading:

--BACKGROUND OF THE INVENTION

1. Field of the Invention--

Page 1, between the first and second paragraphs, please insert the following heading:

--2. Description of the Related Art--

Page 1, between the second and third paragraphs, please insert the following heading:

--SUMMARY OF THE INVENTION--

Page 3, between the third and fourth paragraphs, please insert the following heading:

--BRIEF DESCRIPTION OF THE DRAWINGS--

Page 3, between the fourth and fifth paragraphs, please insert the following heading:

--DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS--.

IN THE CLAIMS

Please cancel claims 1-21 without prejudice or disclaimer in favor of new claims 22-42 as follows:

--22. A floor plank, in particular a multi-layer pressed laminate panel with a decorative paper (12) in the top walked-on layer, which is impregnated with an aminoplastic resin or similar, wherein the particles of an electrically conducting material are applied to the back of decorative paper (12).

23. The floor plank of claim 22, wherein the electrically conducting material is iron powder.

24. The floor plank of claim 22, wherein the electrically conducting material is a copper powder.

25. The floor plank of claim 22, wherein the electrically conducting material is a powder or a copper-based metal alloy.

26. The floor plank of claim 22, wherein the electrically conducting material is graphite dust.

27. The floor plank of claim 22, wherein the electrically conducting material consists of carbon fibers.

28. The floor plank of claim 22, wherein the electrically conducting material is electrically conductive soot.



29. The floor plank of claim 22, wherein the aminoplastic resin is a melamine resin.
30. The floor plank of claim 22, in which, attached to the back of a support, there is a counteracting layer (16) which prevents the support from curling upwards in the event of shrinkage of the decorative paper, wherein the electrically conducting particles are applied to the counteracting layer (16).
31. A method for manufacturing a floor plank, especially a multi-layer laminate panel pressed in one operation, which, as the top walked-on layer, has a decorative paper (12) impregnated with an aminoplastic resin, wherein the particles of an electrically conducting material are applied to the back of the decorative paper (12) impregnated with a resin.
32. The method of claim 31, wherein the electrically conducting particles are sprinkled onto the fresh, not yet hardened resin.
33. The method of claim 31, wherein the electrically conducting particles consist of graphite dust.
34. The method of claim 31, wherein the electrically conducting particles consist of carbon fibers.
35. The method of claim 31, wherein the electrically conducting particles consist of electrically conductive soot.
36. The method of claim 31, wherein the electrically conducting particles consist of iron powder.
37. The method of claim 31, wherein the electrically conducting particles consist of copper powder.

38. The method of claim 31, wherein the electrically conducting particles consist of the metal powder of a copper alloy.

39. The method of claim 31, wherein the electrically conducting particles are applied to the decorative paper (12) before it is fed through a heating furnace.

40. The method of claim 31, wherein the electrically conducting particles are applied to the decorative paper (12) between the first and second stations of a two-stage impregnating furnace after the initial pre-hardening of the resin.

41. The method of claim 31, wherein the particles of the electrically conducting material are applied in a mixture with the resin to the decorative paper (12).

42. The method of claim 31, wherein the resin is a melamine resin.--

#### REMARKS

The purpose of the forgoing Amendment is to delete multiple dependent claims and to insert appropriate headings in order to place the application in better form for examination under U.S. practice. No new matter is entered.

Respectfully submitted,



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